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EXAMINER

GOTTSCHALK, MARTIN A

ART UNIT	PAPER NUMBER
3694	

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/876,311

Applicant(s)

GOODMAN ET AL.

Examiner

Martin A. Gottschalk

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 19 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Notice to Applicant***

1. Claims 1-19 have been examined. Claims 4 and 10 are amended. Claims 14-19 are new. Claims 1-3, 5-9, and 11-13 are the original claims.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the present case, claim 19 recites the same language as claim 16 from which it depends. From context and for the purpose of examination, the Examiner will consider a typographical error to have occurred in claim 19, and that the claim should recite "A method according to claim 18..." as opposed to "A method according to claim 16..."

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5-9, and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown (US Pat# 6,151,586).

A. As per claim 1 Brown discloses a method of incentivising members of a disease management programme to comply with the programme (Brown: col 5, Ins 14-16), the method comprising the steps of:

(a) defining a plurality of general programme (Brown: col 12, Ins 18-23) areas and a plurality of specific programme areas (Brown: col 12, Ins 23-25);

(b) associating each of the plurality of general programme areas with each of the diseases managed by the programme (Brown: col 12, Ins 18-23);

(c) associating each of the plurality of specific programme areas only with those diseases managed by the programme to which the specific programme area is determined to be of particular benefit to a member afflicted with the disease (Brown: col 12, Ins 23-25);

(d) awarding points to a member of each of the programme areas in which the member participates, only if the member is afflicted with a disease which is associated with that particular programme area (Brown: col 8, lns 37-53); and

(e) allocating a reward to the member if the points awarded to the member accumulate to a predetermined amount (Brown: col 23, lns 45-57).

B. As per claim 2, Brown discloses a method according to claim 1, wherein

points are only awarded to the member if the member participates in all of the programme areas which are associated with the disease or diseases with which the member is afflicted (Brown: Fig. 15A and 15B; col 13, ln 19 to col 14, ln 37; Figs. 10 and 11. Note that both criteria of questions being answered and measurements being within limits must be met if the coupon is to be given.)

C. As per claim 3, Brown discloses a method according to claim 1 wherein

additional points are awarded to the member if the member participates in all of the programme areas which are associated with the disease or diseases with which the member is afflicted (The Examiner notes the rejection provided for claim 2 above and further notes that a repetition of this process would result in additional coupons being given. Repetition of the process would be expected for

patients involved in disease management programs associated with chronic diseases such as the examples of diabetes and asthma cited in the Brown reference).

D. As per claim 5, Brown discloses a method according to claim 1 wherein

the specific programme areas are one or more of

blood pressure,

flow volume loop measurement,

influenza vaccine,

pneumococcal vaccine,

cholesterol and

long term glucose control (Brown: Fig. 5A; Fig 5B, item 124; Fig. 6A).

E. As per claim 6, Brown discloses a method according claim 1 further including the steps of:

(a) defining a measurable within at least one of

the general (Brown: col 23, lns 45-57; Figs. 15A and 15B, the Examiner notes that the overall evaluation criteria involves both the compliance questions

of Fig 15A, item 412, and the physiological measurements of Fig. 15B, items 420-424) or

specific programme areas (Brown: col 5, ln 66 to col 6, ln 15, i.e. data from one of the monitoring devices)

so that a members performance within said programme area can be ascertained;

(b) defining a minimum level of the measurable, which minimum level indicates a minimum required level of member performance within the at least one programme area (Brown: col 8, 48-53); and

(c) awarding points to a member if the member obtains the defined minimum level of a measurable for the at least one programme area only if the member is afflicted with a disease which is associated with that particular programme area (Brown: col 8, lns 37-53).

F. As per claim 7, Brown discloses a method according to claim 6 further comprising the step of

awarding additional points to the member if the member obtains the minimum level of a measurable for all of the programme areas which are associated with

the disease with which the member is afflicted (The Examiner notes the rejection provided for claim 6 above and further notes that a repetition of this process would result in additional coupons being given. Repetition of the process would be expected for patients involved in disease management programs associated with chronic diseases such as the examples of diabetes and asthma cited in the Brown reference).

G. As per steps a, b, and c (i.e. the first three steps) of claims 8, 12, and 13, they are rejected for the same reasons as provided above for the corresponding steps of claim 1.

H. As per the steps d of claims 8 and 13, they are rejected for the same reasons provided above for claim 6a.

I. As per the steps e of claims 8 and 13, they are rejected for the same reasons provided above for claim 6b.

J. As per step f of claims 8 and 13, they are rejected for the same reasons provided above for claim 6c. Note that the Examiner considers an individual afflicted with a disease to be someone predisposed to the disease.



K. As per step d of claim 12, it is rejected for the same reason provided above for claim 1d. Note that the Examiner considers an individual afflicted with a disease to be someone predisposed to the disease.

L. As per steps g of claims 8, and 13, and claim 12e, they are rejected for the same reasons as provided above for 1e (the "allocating" step).

M. As per claim 9, it is rejected for the same reasons as provided above for claim 6c.

N. Claim 11 is rejected for the same reasons as provided above for claim 5.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 4, 10, 14, 15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown as applied to claims 1 and 8 above, and further in view of Bro (US Pat# 5,722,418, hereinafter Bro).

A. As per claims 4 and 10, Brown discloses a method according to claim 1 wherein

the general programme areas is

education (Brown col 16, lns 26-35).

but fails to disclose the remaining features of the claim which is well known in the art as evidenced by the teachings of Bro who teaches

the general programme areas are some of

diet,

exercise,

and

smoking (Bro: col 11, lns 12-24).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Bro within the method of Brown with the

motivation of implementing and reinforcing a patient's medical regimens (Bro col 40, Ins 25-27).

B. As per claims 14, 15, 17, and 18 Brown fails to explicitly disclose the features of these claims, however, they are well known in the art as evidenced by the teachings of Bro who teaches

a method according to claim 1 wherein

(claims 14 and 17) the amount of the reward is related to the amount of points accumulated by the member.

and

(claims 15 and 18) the reward is a cash payout or special options on services (for both claims, see Bro: col 38, ln 5, to col 39, ln 10; col 34, ln 3-18 and 31-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Bro within the method of Brown with the

motivation of implementing and reinforcing a patient's medical regimens (Bro col 40, Ins 25-27).

9. Claims 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Bro as applied to claims 15 and 18 above, and further in view of Sehr (US Pat# 6,085,976, hereinafter Sehr).

A. As per claims 16 and 19, Brown and Bro fail to teach the features of these claims, however, these features are well known in the art as evidenced by the teachings of Sehr who teaches a method according to claim 15 (and 18 respectively)

wherein the services are one or more of

airplane tickets,

hotel accommodations,

and

car rentals (Sehr: col 32, ln 64 to col 33, ln 48, note the use of "frequent mileage points" as rewards).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Sehr with the combined teachings of Brown and Bro with the motivation of reducing the administrative costs associated with non-computerized systems (Sehr: col 2, lns 7-26).

### ***Response to Arguments***

10. Applicant's arguments in the response filed 07/19/2006 have been fully considered but they are not persuasive.

A. On pages 9 and 10, Applicant argues that Brown does not distinguish between "general" and "specific" program areas. The Examiner respectfully disagrees and notes from the cited passages that the exemplary program areas of diabetes and asthma are general areas, and that customization of these programs to individual patients represents types of specific program areas.

B. At the top of page 11, Applicant appears to argue that the claimed "awarding points" recited in claim 1, step d is not taught by Brown. The Examiner respectfully disagrees. In addition to the provided passage above, note Brown: Fig 5B which is referenced in the passage. Note that the plurality of monitoring devices correspond to different diseases (e.g. diabetes, hypertension, asthma, obesity). As disclosed in the passage, a patient participating in say, the diabetes program area, clearly would be

afflicted with diabetes, and is rewarded for complying with the "EVALUATION CRITERIA" associated only with that disease.

C. In the last paragraph of page 11, Applicant appears to argue that Brown does not teach the features of amended claims 4, and 10. These arguments are moot in view of the new grounds of rejection provided by the Bro reference.

D. On pages 12 and 13, Applicant argues that Brown does not teach certain features of claim 8 pertaining to what is necessary for the awarding of points – i.e. Brown is based on "overall compliance" versus compliance in separate program areas. It is not clear from this argument as to which feature of claim 8 is being referenced. The Examiner will presume that Applicant is referring to the step which awards points based on obtainment of a "minimum level of a measurable," and notes that FIG 5B and col 8, Ins ~~2~~27-53 clearly teaches a minimum level of measurable (FIG 5B, item 126). The passage further teaches that by checking a criteria box (or leaving it unchecked), the user can specify various criteria. Note that if only the "MINIMUM MEASUREMENT VALUE" is checked, then that would meet the claimed limitation.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MG

10/12/2006



ELLA COLBERT  
PRIMARY EXAMINER